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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,900

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Matthew Waight

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EXAMINER

TRAN, PABLO N

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

08/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/799,900	Applicant(s) WAIGHT ET AL.	
	Examiner Pablo N. Tran	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 4,6,7 and 10-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 8-9 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The indicated allowability of claims 5 and 39 are withdrawn in view of the newly discovered reference(s) to Gomez (US Pat No 7,715,815), Miyagi et al. (US Pat No 2006/0209987), and McCarthy et al. (US Pat No 2003/0193373).

Priority

2. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/460492 fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Provisional Application 60/460492 drawn to a Surgical Implant System. This Provisional Application has no support for all claims 1-39 of the instant Application. Therefore the instant application is not entitle to the earlier provisional date of 04/03/03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 39, the claimed limitation, “a set of test points of the integrated circuit, the test points of the set of test points not directly connected to pins of the integrated circuit” renders the claim indefinite. It is unclear as to the location of these test points. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 8-9, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen (US Pat No 2004/0116096) in view of Gomez (US Pat No 7,715,8153) and in view of Miyagi et al. (hereinafter “Miyagi”, US Pat No 2006/0209987)

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and further in view of McCarthy et al. (hereinafter "McCarthy", US Pat No 2003/0193373).

As per claims 1-3, 8-9, and 38, Shen disclose an integrate circuit comprising a first amplifier (see fig. 1/no. 15); a first oscillator (see fig. 1/no. 21); a first mixer (see fig. 1/no. 19); a second oscillator (see fig. 1/no. 28); a second mixer (see fig. 1/no. 27); a second amplifier (see fig. 1/no. 25); a serial control module (fig. 6/no. 128); a programmable intermediate filter (see fig. 1/no. 23, fig. 3/no. 80) through a control interface (see 0028, 0030).

Shen does not specifically disclose a programmable filter with an arrangement as claimed. However, Gomez disclose such programmable filter comprising a programmable filter include a first filter stage, the first filter stage including a first LC resonator and including a first adjustable capacitor array coupled to the first LC resonator.(see fig. 4, fig. 5, fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention for Shen to utilize the programmable filter, as taught by Gomez, to reduce to number of external components but also to effectively tune to a desired channel.

The modified programmable filter of Shen and Gomes disclose that the capacitor switching matrix can be program to select a capacitor to enable/disable but not explicitly disclose that the capacitor matrix can be program by a data storage location. However, Miyagi disclose that such capacitor matrix can be program by data storage location (see fig. 3, 0019, 003, and 0041). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention for Shen and Gomez to incorporate the filter

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programming method, as taught by Miyagi, to reduce the effort required to select the desired channel.

The modified programmable filter of Shen, Gomez, and Miyagi do not specifically disclose that the capacitor switching matrix can be program by utilizing fuses. However, such method is well-known in the art, as taught by McCarthy (see fig. 1A, fig. 1B. fig. 2, and claim 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention for Shen, Gomez, and Miyagi to incorporate the filter programming method, as taught by McCarthy, to reduce cost and to effectively select the desired channel.

As per claim 5, the modified programmable filter of Shen, Gomez, Miyagi, and McCarthy further disclose the first capacitive array includes a first capacitor coupled in series with a first switch and further coupled in series with a second capacitor and also includes a third capacitor coupled in series with a second switch and further coupled in series with a fourth capacitor and the combination of the third capacitor, second switch and fourth capacitor coupled in parallel with the combination of the first capacitor, first switch and second capacitor (see Gomez, fig. 5, as stated above, it is clear that the programmable filter of Shen, Gomez, Miyagi, and McCarthy offers various methods to program, wherein each of the switches can be program to enable/disable by data storage location, as taught by Miyagi, or fuses can be incorporates as switch, as taught by McCarthy).

As per claim 37, the modified programmable filter of Shen, Gomez, Miyagi, and McCarthy further disclose that a capacitor of the LC resonator is part of the integrated

circuit (see Gomez, fig. 4, fig. 5, fig. 7)

As per claim 39, the modified programmable filter of Shen, Gomez, Miyagi, and McCarthy further disclose the first plurality of programmable data storage locations are programmable through a set of test points of the integrated circuit, the test points of the set of test points not directly connected to pins of the integrated circuit (see Miyagi, fig. 3, 0016-0018).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status information for Published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directauspto.gov>. Should You have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

August 25, 2010

/Pablo N Tran/

Primary Examiner, Art Unit 2618